

REMARKS

Status of Claims

Claims 1-9 and 25-30 are pending in this application. By this Amendment, the Title of the Invention and claims 1-9 and 25-30 have been amended and claims 17-24 have been cancelled. Reconsideration of the rejections of all claims is earnestly solicited in view of the above amendments and the following remarks.

Claim for Domestic Priority

The Office Action asserts that because certain terms appear in the non-provisional application that do not appear in the provisional application, that the non-provisional application will not benefit from the priority claim. This assertion is respectfully traversed. No provision of the U.S. Patent Laws or Rules requires that the non-provisional application be identical to the provisional application in order for priority to be granted. Such a restriction would render provisional applications entirely useless. Furthermore, many of the terms that the Office Action references are prior art terms and some are not part of the claimed invention. In this instance, the provisional application and the non-provisional application have significantly overlapping subject matter and disclose at least some of the same inventions.

The decision of whether priority is to be granted is based on the allowed claims. Since no claims are currently allowed, the assertion in the Office Action that priority has been denied is entirely pre-mature. Section 201.11 of the MPEP explains the procedure for determining priority on a claim-by-claim basis.

Objection to the Specification

The specification was objected to because the title of the invention was not descriptive. The title has been amended in order to expedite the prosecution. Withdrawal of the objection is therefore respectfully requested.

Objection to the Claims

Claims 1, 17, 25, and 28 received an objection because of informalities. Claims 1, 17, 25, and 28 have been amended in accordance with the Examiner's request in order

to expedite the prosecution. Withdrawal of the objection is therefore respectfully requested.

Rejection under 35 U.S.C. § 101

Claims 1-9 and 17-27, were rejected under 35 U.S.C. §101 as being directed to non-statutory subject matter. Independent claims 1 and 25 have been amended and claim 17 has been cancelled in order to expedite the prosecution. Applicants respectfully submit that the pending claims are statutory. Withdrawal of the rejection is respectfully requested.

Rejection under 35 U.S.C. § 112

Claims 1-3, 6-9, 17-23, 25-28, and 30 were rejected because the phrase “such that” renders the claim indefinite because it is unclear whether the limitations following the phrase are part of the claimed invention. The phrase “such that” has been eliminated from the pending claims. Furthermore, the Office Action states that the phrase “same way” renders the claims indefinite. Accordingly, the phrase “same way” has been deleted from the pending claims.

In accordance with the Examiner’s request, the claims have also been amended in order to use the terms “serial” and “non-serial” instead of “legacy” and “non-legacy”. The terms “serial” and “non-serial” should be interpreted in accordance with paragraph five of the specification. As set forth in paragraph five, some keyboards and pointing devices are legacy or serial devices and other keyboards and pointing devices are non-legacy or non-serial devices. Thus, it is not possible to provide a “list of devices” in the claims. As set forth in paragraph five, it is the type of connectivity and not the nature of the input device that determines if it is a legacy or non-legacy device.

Withdrawal of the rejection under 35 U.S.C. §112 is therefore respectfully requested.

Rejection under 35 U.S.C. § 102(e)

Claims 1, 25, and 28 were rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,081,855 to DeCarmo in view of U.S. Patent No. 5,991,546 to Chan *et al.* (hereinafter “Chan”). This rejection is respectfully traversed.

Since a rejection under any section of §102 and the general concept of “anticipation” require that a single reference disclose all of the claimed features, this rejection has also been treated as a rejection under 35 U.S.C. §103 in order to be fully responsive.

The Office Action states that DeCarmo discloses all features of the claims 1, 25, and 28 except for the provision of support for legacy and non-legacy input devices. The Office Action provides the disclosure of Chan to illustrate that techniques are available for supporting both legacy and non-legacy input devices.

However, even if combined DeCarmo and Chan fail to disclose each and every feature of the invention of claims 1, 25, and 28. Both DeCarmo and Chan fail to disclose at least a device addition process for adding additional serial input devices and additional non-serial input devices, the device addition process requiring a registration determination step for the additional non-serial input devices and skipping the registration determination step for the additional serial input devices.

DeCarmo discloses an input manager for a DVD player. As shown in FIG. 3, the input manager typically acts between each device driver and the single application that controls the DVD player. FIGs. 7A and 7B illustrate a process for loading device drivers. The corresponding description is provided from Column 8, line 54 through Column 9, line 16. The process of DeCarmo follows identical steps regardless of the type of device being added. Accordingly, DeCarmo fails to provide a registration determination step for non-serial input devices and skipping a registration determination step for serial input devices.

Chan discloses a system for interfacing manually controllable input devices to a universal computer bus system. In other words, given the development of the Universal Serial Bus Architecture (USB), Chan seeks to find a technique for incorporating existing legacy devices in the new USB architecture, rather than allowing non-legacy devices to

be incorporated in the same manner that legacy devices are currently incorporated. As set forth above, Chan also fails to show at least a device addition process for adding additional serial input devices and additional non-serial input devices, the device addition process requiring a registration determination step for the additional non-serial input devices and skipping the registration determination step for the additional serial input devices.

In order to make out a *prima facie* case of obviousness, the references cited by the Examiner must provide all of the elements of the invention as claimed and a suggestion to combine the disclosures of the various cited art references to make the claimed invention. *In re Geiger*, 815 F.2d 686, 688 2 USPQ2d 1276, 1278 (Fed. Cir. 1987); *ACS Hospital Systems, Inc. v. Montefiore Hospital*, 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984).

Furthermore, in order to make a *prima facie* case of obviousness, a teaching or suggestion of the combination must be found in the prior art. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). Both references fail to provide any teaching or suggestion for making the proposed combination. Since DeCarmo provides a system for managing input for a DVD player, DeCarmo is likely unconcerned with incorporation of legacy or “serial” devices. DeCarmo would likely incorporate only non-serial devices. Additionally, Chan, while recognizing the possibility for the continued use of legacy input devices, expects the legacy devices to be incorporated in a USB processing environment. Accordingly, the references teach away from the claimed invention.

Claims 2-6, 8, 17, 18, 20-24, 26, 27, 29, and 30 are rejected under 35 U.S.C. § 102(e) as being anticipated by DeCarmo and Chan in view of Sun (U.S. Patent No. 6,643,721). This rejection is respectfully traversed.

As set forth above, this rejection has also been treated as a rejection based on obviousness under 35 U.S.C. §103 in order to be fully responsive. Sun fails to obviate the deficiencies of DeCarmo and Chan noted above. Accordingly, these dependent claims define over the art of record for at least the reasons set forth above with regard to the respective dependent claims. Withdrawal of the rejection is therefore respectfully requested.

Claims 7, 9, 16, and 19 were rejected under 35 U.S.C. § 102(e) as being anticipated by DeCarmo, Chan and Sun in view of "Official Notice". This rejection is respectfully traversed.

As set forth above, this rejection has also been treated as a rejection based on obviousness under 35 U.S.C. §103 in order to be fully responsive. The Examiner's Official Notice fails to obviate the deficiencies of DeCarmo and Chan noted above. Accordingly, these dependent claims define over the art of record for at least the reasons set forth above with regard to the respective dependent claims. Withdrawal of the rejection is therefore respectfully requested.

CONCLUSION

Claims 1-9 and 25-30 are pending in this application. In view of the amendments and remarks, applicants respectfully request that this application be allowed and passed to issue. Should any issues remain prior to issuance of this application, the Examiner is urged to contact the undersigned prior to resolve the same. The Commissioner is hereby authorized to charge any additional amount required, or credit any overpayment, to Deposit Account No. 19-2112 referencing Attorney Docket No. MFCP.87506.

Respectfully submitted,

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